

Application No.: 09/889,807

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REMARKS

Claims 1-3 and 5-63 are pending in the application. Claims 64-86 are added. Applicants request entry and consideration of the amendments and response herein.

Amendment of any claim herein is not to be construed as acquiescence to any of the rejections/objections set forth in the instant Office Action, and was done to expedite prosecution of the application. Applicants make these amendments without prejudice to pursuing the original subject matter of this application in a later filed application claiming benefit of the instant application, including without prejudice to any determination of equivalents of the claimed subject matter. Support for these amendments appears throughout the specification and claims as filed. No new matter is introduced by these amendments.

Claim Objections

Claim 5 is objected to as being in improper dependent form for failing to further limit the subject matter of a previous claim. Applicants traverse. Applicants have cancelled claim 5 rendering the objection moot and request withdrawal of this objection.

Claim 14 is objected to as being in improper multiple dependent form for depending from a cancelled claim. Applicants have amended claim 14 to proper form and request withdrawal of this objection.

Claims 42, 43 and 53-57 are objected to as being in improper multiple dependent form for depending from another multiple dependent claim. Applicants have amended claims 41-43, and 53-57 and added new claims 70-86 to remove multiple dependencies. Applicants therefore request withdrawal of the objection.

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Rejection under 35 U.S.C. §112, first paragraph

Claims 1-3 and 5-63 are rejected as failing to comply with the enablement requirement. Claim 1 is rejected in regard to step (4). In the Action, it is alleged that one of ordinary skill in the art would not know how to make selection of a product. Applicants traverse.

One of ordinary skill reading Applicants' specification and claims would understand and appreciate selection as delineated in step (4) of Applicants' claimed subject matter. Throughout the specification and claims it is clear that the practitioner is desirous of "chemical compounds with desired and useful physical, chemical and/or biological properties." See, Specification at page 1, paragraph 1. The Specification is replete with description of this goal and criteria to attain it, including specifically at: (i) page 8, lines 11-19, which describes desirability based on biological activity; (ii) page 12, lines 15-20, which describes desirability based on various further properties such as medicaments, veterinary products, vaccines, cosmetics, plant protection, etc.; (iii) page 18, lines 28-34, which describes properties, including biological activity, effectiveness, side effects, selectivity, etc.; and (iv) page 21, which describes evaluation, that is, sorting or comparing the properties of one compound relative to one or more other compounds in order to rank or select a desired compound. As such, it is clear to one of ordinary skill (e.g., a skilled medicinal chemist, agricultural chemist, etc.) of how selection is performed. Nonetheless, to further clarify the point, Applicants have amended claim 1, step(4) to recite evaluation based on "for one or more biological, pharmacological, or physicochemical criterion." As such, Applicants submit that claim 1 meets the requirements for enablement and respectfully request that the rejection be withdrawn.

Furthermore, claim 1 is interpreted to encompass *in silico* methods. It is asserted in the Action, however, that the specification does not enable one of ordinary skill to execute the claimed method *in silico*. Applicants traverse.

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Applicants have amended claim 1 (and dependent claims thereby) to recite in step (2) of the method, "chemical" reaction, thus indicating the physical reaction of starting materials. Applicants submit that *in silico* methods are not encompassed and request withdrawal of the rejection.

Rejection under 35 U.S.C. §112, second paragraph

Claims 1-3 and 5-63 are rejected as indefinite. Applicants traverse each of the bases identified in the Action individually, and address each below.

Claims 1, 3 and 22 are rejected as allegedly indefinite based on the term "suitable". Applicants have amended the claim to remove reference to such term thus rendering the rejection moot.

Claim 1 is rejected as allegedly indefinite based on the term "products". Applicants have amended the claim to provide antecedent basis to such term thus rendering the rejection moot.

Claim 1 steps (3) and (4) is rejected as allegedly indefinite based on being redundant. Applicants submit that "analyzing" and "evaluating" are distinct. As indicated throughout the specification and claims, including specifically at pages 18-19 (which describes analysis, that is, ascertaining physicochemical properties of the compounds) and page 21 (which describes evaluation, that is, sorting or comparing the properties of one compound relative to one or more other compounds in order to rank or select a desired compound), the two functions are quite different and distinct. Applicants submit that one of ordinary skill reading Applicants' specification would readily understand and appreciate the distinction. Applicants therefore request withdrawal of the rejection.

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Claim 6 is rejected as allegedly duplicative regarding "evaluation". Applicants have amended claim 1 to more clearly delineate that claims 1 and 6 are in fact distinguishable. Applicants therefore request withdrawal of the rejection.

Claim 8 is rejected as allegedly unclear regarding what is being evaluated and to what the phrase "is if appropriate carried out" refers to. Applicants are unsure as to the lack of clarity regarding "what is being evaluated" as step (7) has no "evaluation" feature in it. Applicants have deleted the phrase "if appropriate". Applicants therefore request withdrawal of the rejection.

Claims 8 and 34 are allegedly indefinite based on the term "appropriate". Applicants have amended the claims to remove reference to such term thus rendering the rejection moot.

Claims 10, 23 and 46 are allegedly indefinite based on the phrase "such as". Applicants have amended the claims to remove reference to such phrase thus rendering the rejection moot. In doing so, new claims 64 and 69 are added to recite subject matter deleted from claims 23 and 46, respectively.

Claim 22 is allegedly indefinite based on the term "suitable". Applicants have amended the claim to remove reference to such term thus rendering the rejection moot.

Claims 22, 24 and 37 are allegedly indefinite based on the phrase "for example". Applicants have amended the claims to remove reference to such phrase thus rendering the rejection moot. In doing so, new claims 65-66 and 68, are added to recite subject matter deleted from claims 24 and 37, respectively.

Claim 30 is allegedly indefinite based on the term "preferably". Applicants have amended the claim to remove reference to such term (and added claim 67 reciting the preferred number of components deleted from claim 30) thus rendering the rejection moot.

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Claim 44 is allegedly indefinite based on the term "especially". Applicants have amended the claim to remove reference to such term thus rendering the rejection moot.

Claim 48 is allegedly indefinite based on the term "best". Applicants have amended the claim to remove reference to such term thus rendering the rejection moot.

Claim 15 is allegedly indefinite based on the phrase "starting materials are provided with protecting groups." Applicants have amended the claim to clarify that the starting materials have functional groups that are "protected with protecting groups" thus rendering the rejection moot.

In view of the above amendment and arguments, Applicants believe the pending application is in condition for allowance. The Director is hereby authorized to charge or credit any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 04-1105, under Order No. (41925) 56268.

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Respectfully submitted,

By

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